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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,584	04/16/2001	Eugeniusz Rylewski	154.1049	3718
21171	7590	12/08/2003	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			CIRIC, LJILJANA V	
			ART UNIT	PAPER NUMBER
			3753	

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/786,584

Applicant(s)  
Rylewski

Examiner

Ljiljana V. Cirio

Art Unit

3753



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 23, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-19 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 16, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Jan 28, 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 3743

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 20, 2003 has been entered.
2. Claims 12 through 19 as amended remain in the application.

### *Response to Arguments*

3. Applicant's arguments filed on August 20, 2003 regarding the previously cited prior art rejections of the claims of the instant application have been fully considered but they are not persuasive.

Once again, as a preface to the following traversal of applicant's arguments, the examiner hereby notes that the claims in a pending application should be given their *broadest* reasonable interpretation. See In re Person, 181 USPQ 641 (CCPA 1974).

Applicant is also respectfully reminded that claims directed to apparatus must be distinguished from the prior art *in terms of structure* rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Also, "[A]pparatus claims cover what a device *is*, not what a device *does*. (Emphasis in original). Hewlett-Packard Co. v. Bausch & Lomb

Art Unit: 3743

*Inc.*, 909 F.2d 1464, 1469 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Applicant's patentability arguments are not persuasive because these focus on the potential operational or functional differences between the prior art apparatus and the apparatus of the instant invention as claimed *without* pointing out any patentably significant claimed structural differences between the same. Furthermore, the applicant relies on the fluid passages of the inventive heat exchanger unit being under pressure when the air circulators or fans are operating; nevertheless, as noted in greater detail below, any air flows generated by a fan or an air circulator are inherently "under pressure".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the instant inventive apparatus NOT having walls which are deformed using a string and/or the instant inventive apparatus avoiding the need for limiting deformation through the use of strings or the like to maintain distances between the fluid passages of the heat exchanger unit) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments with regard to the *Harrison* reference are not clearly understood in their entirety. However, merely spacing the folds of a flexible material (i.e., the paper) using sand does *not* preclude the flexible material from being deformed by the forced circulation of a fluid therethrough. Similarly, limiting the deformation of a flow passage made of a flexible material by

Art Unit: 3743

using strings to maintain separation of the walls of the flow passage also does not preclude the flexible material from being deformed by the forced circulation of a fluid therethrough.

Applicant's arguments thus do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

#### ***Drawings***

4. Absent any arguments to the contrary by the applicant, the examiner's disapproval of the proposed drawing correction and/or the proposed substitute sheets of drawings, filed on January 28, 2003, on the basis of these introducing new matter stands. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure, while providing for plural fans and heat exchangers per se, does not support the showing of the particular configuration and physical interrelationships between the various fans and heat exchangers as now shown in proposed new Figure 12. Proposed new Figure 12 has thus not been approved for entry.

#### ***Claim Objections***

5. Claims 12 through 19 are objected to because of the following informalities: "in one of the fluid passages" [claim 12, line 7] should be replaced with "in one of the two fluid passages" for improved consistency; "in the other of the fluid passages" [claim 12, line 8] should be replaced with "in the other one of the two fluid passages" or with "in the other of the two fluid passages"

Art Unit: 3743

for improved consistency; and, "said stream of fresh air and said stream of stale air" [claim 12, lines 14-15] should be replaced with "the stream of fresh air and the stream of stale air" for improved consistency. Appropriate correction is required.

***Claim Rejections - 35 U.S.C. § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 12 through 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, with regard to base claim 12 as amended, the limitations "wherein the air circulator introduces the stream of fresh air and the stream of stale air, both under pressure, in the respective fluid passages, defining open channels in the flexible foil providing for the circulation of said stream of fresh air and said stream of stale air in the heat exchange unit" are written in a run-on fashion and are thus not clear. For example, it is not clear whether the introduction of the stream of fresh air and the introduction of the stream of stale air under pressure into the respective fluid passages by the air circulator defines the open channels in the flexible foil or whether the respective fluid passages define open channels in the flexible foil to provide for the circulation of the stream of fresh air and the stream of stale air in the heat exchanger unit by the air circulator.

***Claim Rejections - 35 U.S.C. § 102***

Art Unit: 3743

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. As best can be understood in view of the indefiniteness of the claims, claims 12 through 14 and 16 through 18 are rejected under 35 U.S.C. 102(b) as being anticipated by *Oberschmid (DE 40 07 963 A1--of record)*.

*Oberschmid (DE 40 07 963 A1)*, especially Figure 3, discloses a heat exchange unit essentially as claimed, including: a box provided with walls 1 as shown in Figure 3 [which is associated with Figures 2a and 2b, as well as claim 13 of the reference] defining two fluid passages 3 and 4 having a cross section of undulating shape along the length of the heat exchanger box as shown in Figures 2a and 3, the walls bounding the fluid passages including a removable thin flexible foil which is air-tight and impermeable to water vapor; and, an air circulator including at least one entry fan 10 and at least one extraction fan 11. An operating air circulator or fan or pump or blower inherently produces air streams *under pressure*. Also, thin flexible foil is inherently capable of being deformed as a function of the air pressure variations due to forced air or other fluid flow therethrough. Turning an apparatus on its end, and thereby changing the relative orientation of the component elements of the apparatus--such as by rotating the apparatus from a horizontal orientation to a vertical orientation, does not change the structure of the apparatus and is thus immaterial to the patentability of the same.

Art Unit: 3743

The reference thus reads on the claims.

10. Alternately for claims 12, 13, 16, and 17, and as best can be understood in view of the indefiniteness of the claims, claims 12, 13, 15 through 17 are rejected under 35 U.S.C. 102(b) as being anticipated by *Harrison (of record)*.

*Harrison* discloses a heat exchange unit essentially as claimed, including: a box or mounting member 14 having walls [as shown in Figure 2] defining two fluid passages having a cross section of undulating shape along the length of the heat exchanger box 14, the walls bounding the fluid passages including a removable paper “foil” which is water-permeable [see the abstract of the reference]; and, an air circulator or fan 20. The paper “foil” is inherently air-tight. An operating air circulator or fan or pump or blower inherently produces air streams *under pressure*. Also, thin flexible foil is inherently capable of being deformed as a function of the air pressure variations due to forced air or other fluid flow therethrough. Turning an apparatus on its end and thus changing the relative orientation of its elements, such as from horizontally-oriented to vertically-oriented, does not change the structure of the apparatus and is thus immaterial to the patentability of the apparatus.

The reference thus reads on the claims.

***Claim Rejections - 35 U.S.C. § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person



Art Unit: 3743

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. As best can be understood in view of the indefiniteness of the claims, claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Oberschmid* (DE 40 07 963 A1--of record).

*Oberschmid* (DE 40 07 963 A1--of record) discloses a heat exchange unit essentially as claimed, as noted in greater detail above, but does not necessarily disclose either the location of the fans as being exactly as recited in claim 19 of the instant application, for example, or there being two extraction fans 11 instead of one. Nevertheless, shifting the location of parts, absent unexpected results, as well as duplicating parts for a multiplied effect, are matters of design choice and are thus not inventive. See *St. Regis Paper Co. V. Bemis Co., Inc.*, 193 USPQ 8, 11 (7th Cir. 1977) and *In re Japikse*, 86 USPQ 70 (CCPA 1950).

Thus, it would have been obvious to one skilled in the art at the time of invention to modify the heat exchange unit of *Oberschmid* by shifting the locations of the fans in order to effect particular flow patterns or conform with particular space requirements for a given application and/or by duplicating the number of fans within the unit in order to double the amount of airflow and/or heat exchange effected thereby.

### ***Conclusion***

13. The following additional prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Malhammar* (filed June 7, 2000), *Shore*, *Tadahiro Yuuki*, *Chelyabinskgrazhdan*, *Matsushita Denko K.K.*, *Bridgestone K.K.*, and *Bauakademie der DDR* each discloses a heat exchanger unit with flexible flow passages.

Art Unit: 3743

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925.

Applicant is encouraged to contact the examiner for clarification of any portion of this Office action if needed.

While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (703) 308-1272.

The NEW central official fax phone number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

November 28, 2003

  
LJILJANA V. CIRIC  
PRIMARY EXAMINER  
ART UNIT 3753